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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,039	03/13/2001	Hidefumi Yoshida	1095.1166	8847
21171	7590	11/19/2007		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER OYEBISI, OJO O	
			ART UNIT 3694	PAPER NUMBER
			MAIL DATE 11/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/804,039

Applicant(s)

YOSHIDA, HIDEFUMI

Examiner

OJO O. OYEBISI

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

In the amendment filed on 08/30/07, the following have occurred: claim 7 has been amended and claims 1-3, and 5-8 remain pending.

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
2. Claims 1-3, and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwartz et al (Schwartz hereinafter, US PAT pub. #: 2001/0044787) in view of Miller (Michael Miller, The complete Idiot's Guide to Ebay Online Auctions, copyright July 1999).

**Re claims** 1-3, and 5-8. Schwartz discloses a transaction supporting apparatus for use by an intermediary agent in supporting payment of a transaction made between a buyer and a seller, said apparatus comprising: issuing means for

issuing a membership number to the buyer upon a first purchase of any product using the intermediary agent (see pg.5 paras 0097); sending means (i.e., (the internet) "In some preferred embodiments, the secure private agent executes the payment instructions of the consumer, and arranges to pay the merchant against a private credit balance between the trusted third party and the consumer, a commercial credit card authorization, or other conventional payment mechanism which can be effected via the internet," see pg 2 paras 0023, also see pg 5 paras 0081) **for sending the membership number of the buyer to a delivery service agent who delivers the product to the buyer; receiving means for receiving credit card information about a credit card account of the buyer (see pg 5 paras 0095, also see pg.9 paras 0142) via the delivery service agent upon delivery of the product to the buyer, only once the first time the buyer uses the intermediary agent for payment for a purchase;** registering means for registering credit card account information of the buyer received via the delivery service agent, together with the membership number of the buyer (see pg 5 paras 0083-0086); payment information notifying means for notifying the buyer of payment information that requests the buyer to transfer money to a bank account of the seller (see pg 11, paras 0196). Schwartz does not explicitly disclose notifying the buyer of payment information that requests the buyer to transfer money to a bank account of the seller by other means than the registered credit card account of the buyer before a specified deadline expires in response to which the buyer may transfer money to the bank account of the

seller by means other than the registered credit account of the buyer; payment confirming means for confirming whether the requested money transfer of the buyer has been made by the other means than the registered credit card account to the seller's bank account by the specified deadline, and charging means for charging the buyer by the intermediary agent for the transaction via the credit card account identified from the credit card information registered together with the membership number of the buyer, only if said payment confirming means finds that the requested money transfer to the seller's bank account by the other means than the registered credit card account has not been made by the deadline. However, Michael explicitly compensates for the incomplete teachings of Shwartz supra by teaching all the limitations that Shwartz fails to teach supra (i.e., escrow service, as side a side benefit, escrow services also allow you to pay by credit card – even if you're buying from a non-credit card enabled individual... see pg 271, also see pg 272 “ Here's how a typical escrow transaction works.”). Thus it would have been obvious to one of ordinary skill in the art to combine the teachings of Shwartz and that of Michael to provide security to the buyer's credit information and to allow buyers to pay by credit card – even if they're buying from a non-credit card enabled individual.

### ***Response to Arguments***

3. Applicant's arguments filed 08/30/07 have been fully considered but they are not persuasive. The applicant argues in substance that his claimed invention does not make use of an escrow service as taught by Michael Miller, but rather payment is

sent straight from the buyer to seller. Contrary to applicant's assertion, the examiner contends that applicant discloses payment via an intermediary agent (please see fig.3 of applicant's spec). Thus, the escrow service taught by Miller is akin to the intermediary agent disclosed by the applicant, and it would have been obvious to one of ordinary skill in the art to combine the teachings of Schwartz and that of Michael to provide security to the buyer's credit information and to allow buyers to pay by credit card – even if they're buying from a non-credit card enabled individual. Let us assume, for the sake of argument, that the applicant does not make use of an intermediary agent for payment (i.e., escrow service), this assumption alone is not enough to obviate the teaching of the secondary reference i.e., Michael Miller. The examiner contends that the teaching of the secondary reference (Michael Miller) i.e., ability to pay by credit card – even if you're buying from a non-credit card enabled individual... see pg 271, also see pg 272, is what is relevant in this context. That is to say, the test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OJO O. OYEBISI whose telephone number is (571) 272-8298. The examiner can normally be reached on 8:30A.M-5:30P.M.

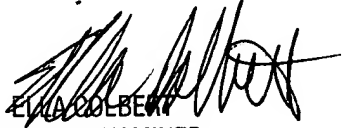
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES TRAMMELL can be reached on (571)272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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E. A. COLBERT  
PRIMARY EXAMINER